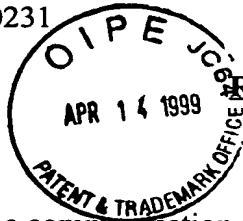


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of : W. Grell et al. ) Art Unit: 1611  
Serial No. : 08/946,602 ) Examiner R.L. Raymond  
Filed : October 7, 1997  
For : PHENYLACETIC ACID BENZYLAMIDES

Assistant Commissioner For Patents  
Washington, D.C. 20231



RESPONSE

Sir:

This is in response to a communication received from the Examiner in charge of the subject application, which communication was mailed on October 13, 1998.

In the communication mailed October 13<sup>th</sup>, the Examiner notes that no reference was made to the foreign priority claimed in U.S. Pat. 5,216,167. The benefit of foreign priority under 35 U.S.C. §119 of the following foreign patent applications was and is claimed:

3347565 (Germany) filed December 30, 1983;  
3522604 (Germany) filed June 25, 1985; and  
3523466 (Germany) filed July 1, 1985.

Additionally, the benefit under 35 U.S.C. §120 of the U.S. patent applications listed below is also claimed:

07/495,820 filed March 19, 1990, (now U.S. Pat. 5,216,167)  
07/302,022 filed January 25, 1989;  
06/878,921 filed June 26, 1986;  
06/872,706 filed June 10, 1986; and  
06/684,054 filed December 20, 1984.

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Regarding the drawings, such were inadvertently omitted from the reissue application as filed. However, such drawings are part of U.S. Pat. 5,216,167 and a copy of such drawings is enclosed.

Regarding the Examiner's request for a Form PTO-1449, such form is enclosed with the instant response. Copies of all the references cited in such PTO-1449 are also enclosed or will be forwarded shortly under separate cover.

Finally, the Examiner has rejected the reissue as filed because the nature of the defect requiring reissue is not specified in detail, nor has a terminal disclaimer been submitted. Applicants' attorney has prepared new reissue declarations for the assignee, Dr. Karl Thomae GmbH and inventors. Applicants' attorney has not yet received such signed declarations, but expects to forward such declarations shortly to the Office. In such declarations, the reason for reissue is stated as follows:

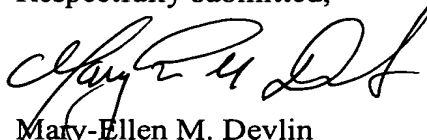
The terminal disclaimer filed on August 6, 1992, in connection with U.S. Serial No. 07/495,820, the application from which U.S. Patent No. 5,216,167 issued, disclaimed only the term of any patent issuing from that application subsequent to October 10, 2006, *i.e.*, the expiration date of U.S. Patent No. 4,873,080. However, both U.S. Patent Nos. 4,873,080 and 4,863,724 are co-owned by assignee Dr. Karl Thomae GmbH, and both disclose and claim subject matter relating to repaglinide. Thus, in an abundance of caution, the assignee believes that U.S. Patent No. 5,216,167 should be terminally disclaimed over both U.S. Patent Nos. 4,873,080 and 4,863,724. Accordingly, a terminal disclaimer which disclaims the term of U.S. Patent No. 5,216,167 subsequent to September 5, 2006, *i.e.*, the expiration date of U.S. Patent No. 4,863,724, is submitted herewith.

A terminal disclaimer, together with transmittal of the fee for filing such, is enclosed.

Finally applicants' attorney wishes to bring to the Examiner's attention the filing of a Request for a Certificate of Correction for U.S. Pat 5,216,167. Such request was filed on October 13, 1998. A copy of the request as filed is enclosed.

In view of the foregoing it is respectfully submitted that reissue of U.S. Pat. 5,216,167 is appropriate, and such favorable action on the subject application is earnestly solicited.

Respectfully submitted,



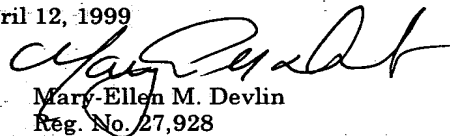
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Case No.: 5/891-1-C1  
Date: April 12, 1999

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to:

Assistant Commissioner For Patents  
Washington, DC 20231

on April 12, 1999



By: Mary-Ellen M. Devlin  
Reg. No. 27,928